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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,096	12/13/2001	Kenji Aiyama	83380.0001	6502
26021	7590	10/17/2003	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			HAMDAN, WASSEEM H	
		ART UNIT	PAPER NUMBER	
		2854		

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/017,096	AIYAMA, KENJI	
	Examiner	Art Unit	
	Wassem H Hamdan	2854	MA4

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 September 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 12-17,22-27 and 33-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 22-27,33-35,37 and 38 is/are allowed.

6) Claim(s) 12-17 and 36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 13 December 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12, 13, 15, 16 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Freedman (US Patent 4,839,829).

Regarding claim 36, Freedman discloses a data processing apparatus adapted for communicating with a client and a plurality of image processing apparatuses through a network [FIG 1A, column 3, lines 49-54], comprising:

a storage device for storing data representing characteristics of each of the plurality of image processing apparatuses [FIG 1A (32; 30 and 34);  
a calculation section [FIG. 1A (10); column 3, lines 56-57; column 4, lines 25-26;  
column 12, lines 12-14; column 12, lines 19-42] for receiving print data through the network, the print data being in a format non-specific to the plurality of image processing apparatuses; and  
a selector [FIG. 1A (10); column 11, lines 61-67] for selecting one of the image processing apparatuses based on the cost data [FIG. 1A (10); column 11, lines 11-16].

Even though Freedman does not explicitly disclose “generating a plurality of image data from the print data based on characteristics of the plurality of image processing apparatuses”,

which it is an functional step or it is an intend use for the claimed data processing apparatus which in fact the Freedman's system or apparatus is capable of performing the same function .

Regarding claim 12, Freedman discloses further comprising a transmitter [FIG. 1A (10); column 3, lines 62-63; column 4, lines 1-2; column 4, lines 62-65; column 8, lines 15-20] for transmitting the print data and an instruction to execute printing of the print data to the selected image processing apparatus [FIG. 1A (10); column 11, lines 61-67].

Regarding claim 13, Freedman discloses the selector selects an image processing apparatus with the lowest cost [FIG. 1A (10); column 11, lines 12-16].

Regarding claim 15, Freedman discloses wherein the selector uses, as a condition for selecting an image processing apparatus, printing condition data associated with the print data received through the network including at least one of a size of paper, a type of paper, whether or not a two-sided printing is conducted, whether or not a binding process is conducted after printing, whether or not a stapling process is conducted after printing, a method of delivery after printing, and the number of prints [FIG. 1A; column 11, lines 64-68; column 12, lines 1-2 and 19-42].

Regarding claim 16, Freedman discloses wherein the selector uses, as a condition for selecting an image processing apparatus, at least one of the number of pages of images and the

consumption amount of consumables [FIG. 1A; column 1, lines 17-22; column 11, lines 64-68; column 12, lines 1-2 and 19-42].

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman (US Patent 4,839,829) in view of White Publication No. (US 2002/0063887 A1).

Regarding claim 14, Freedman discloses the essential elements of the claimed invention. However, Freedman does not disclose the print data includes data in portable document format (PDF). White discloses the print data includes data in portable document format (PDF) since the print data PDF format enhances the document and it is also a document cost factor [page 3, sections [0036 and 0039]]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Freedman by including the print data includes data in portable document format (PDF), one having ordinary skill in the art would recognize from white that a portable document format (PDF) would be beneficial for the purpose of enhancing the document and identifying a cost of a print data (processing services) [White: page 3, sections [0036 and 0039]].

4. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman (US Patent 4,839,829) in view of Robinson et al. (US Patent 5,850,584).

Regarding claim 17, Freedman discloses the essential elements of the claimed invention. Freedman discloses wherein the selector uses, as a condition for selecting an image processing apparatus, a rate color image to be formed [column 1, lines 17-22; column 2, lines 33-35; column 11, l22-26]. However, Freedman does not disclose a black and white image to be formed. Robinson et al. discloses a black and white image to be formed [FIG. 1; column 5, lines 16-19]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Freedman by including a white image to be formed, one having ordinary skill in the art would recognize from Robinson et al. that a black and white image to be formed would be beneficial for the purpose of having greater image density which can greatly affect the reproducing image quality [Robinson et al.: column 5, lines 25-27] and also in some case it is a cost factor.

#### *Allowable Subject Matter*

1. Claims 22-27, 33-35, 37 and 38, are allowed.

Regarding claim 37, the prior art of records does not teach all the combined steps for a print control program for controlling a print operation including the step generating a plurality of image data from the print data based on characteristics of the plurality of image processing apparatuses, each image data being specific to one of the plurality of image processing apparatus; and generating, based on the plurality of image data, cost estimate data representing cost required for producing an image from the print data by each image processing apparatuses.

Regarding claim 38, the prior art of records does not teach all the combined steps for a computer program executed by a computer of a data processing apparatus adapted for communicating with a plurality of image processing apparatuses through a network including a program code for generating a plurality of image data from the print data based on stored data representing characteristics of the plurality of image processing apparatuses, each image data being specific to one of the plurality of image processing apparatus, and a program code for generating, based on the plurality of image data, cost estimate data representing cost required for producing an image from the print data by each image processing apparatuses.

***Response to Arguments***

1. Applicant's argues filed on 09/22/2003 have been fully considered. The Amendment is insufficient for claims 36, 12-17 to overcome the prior art of record.

In response to applicant's argument that "generating a plurality of image data from the print data based on characteristics of the plurality of image processing apparatuses, each image data being specific to one of the plurality of image processing apparatus, and for generating, based on the plurality of image data, cost estimate data representing cost required for producing an image from the print data by each image processing apparatuses", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant application, the “generating” language of the claim does not result in a structural difference between the claimed invention and the prior art because this language is directed to how the structure was obtained, and not the structure itself.

***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mr. Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0956.



Wasseem H. Hamdan

September 30, 2003



ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
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